

Serial No.09/807,943

April 29, 2004

Page 2

a list of various parameters into a unique DNA fingerprint. Note that the MPEP explanation of "nonfunctional descriptive data" recognizes that the functional interrelationship can be created either as part of the stored data, or as part of the computing processes performed by the computer. As such, it is not required that claim 17 recite "executable code that would cause a computer to execute a specific process" in order for claim 17 to constitute a statutory article of manufacture. Claim 17 defines a useful article of manufacture because it sets forth that the data stored in the computer-readable storage medium is acted upon by a specific process executed by the computer, which causes the data to be converted (i.e., transformed) into a unique DNA fingerprint that identifies a specific trait of a source of genomic DNA. Thus, claim 17 creates the functional interrelationship between the data stored in the medium and the process that is performed by the computer on such data. MPEP makes clear that the functional interrelationship does not have to be formed as part of the stored data, i.e. as computer-executable code, but can be part of the computing process performed by the computer on the stored data, which is precisely what is set forth in claim 17. Consequently, the Examiner is requested to reconsider the rejection of claim 17 on non-statutory grounds and to withdraw this ground of rejection.

35 U.S.C. § 112 First Paragraph Rejection

The continued rejection of claims 1-7, 9-14, 16 and 17 under the first paragraph of 35 U.S.C. § 112 based on alleged lack of enablement, and the additional rejection of claim 17 as allegedly failing to comply with the written description requirement, are respectfully traversed.

Applicants vigorously disagree with the Examiner's position that the recitation of computer functional interrelationship with the unique DNA fingerprint data whereby the computer converts the data into a unique DNA fingerprint constitutes new matter. To the contrary, the functionality of the computer that is recited in claim 17 is disclosed and described in Fig. 1 of the application together with the corresponding written description as originally filed. The entire point and purpose of the invention is the development of a standard for facilitating the identification of unique DNA fingerprints. The test for compliance with the written description requirement is whether those skilled

Serial No.09/807,943

April 29, 2004

Page 3

in the art would have recognized that applicant was in possession of the claimed invention from the specification and claims as originally filed. Clearly, the entire specification as filed is directed to obtaining DNA fingerprint profile data that is capable of identifying particular DNA. As such, it is not understood how the Examiner can take the position that the concepts set forth in claim 17 as amended cannot be found from the original disclosure. This position is in error and should be withdrawn.

The rejection of claims 1-7, 9-14, 16 and 17 on non-enablement grounds also is in error and should be withdrawn. The basis of the rejection is that the specification "does not reasonably provide enablement for obtaining DNA fingerprint profile data through alignment by all other means." The Examiner, however, never explains what "other" means encompassed by the claims – in other words, the Examiner has failed to construe the claims for purposes of examination.

Examiner has failed to properly construe the meaning and scope of the claims under the rules of patent application claim interpretation. The Examiner instead has simply compared the claim recitations with the specification, and concluded that the claims are non-enabled because they do not include all the details of the spring-and-rubberband algorithm as set forth in the specification. This position is contradicted by the Examiner's own acknowledgment that "the specification [is] enabling for the disclosed method for obtaining DNA fingerprint profile data." Final Rejection, pp. 3-4. Of course, if the specification is enabling for the invention disclosed therein, and the claims as properly construed are supported by that specification, then the claims cannot be unpatentable on the basis of a lack of enablement.

Moreover, there is no legal basis for the Examiner's conclusion that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use "the invention commensurate in scope with these claims." The Examiner has failed to articulate the scope of the claims because the Examiner has not construed the meaning of the claims. The claims must be interpreted in light of the specification. To the contrary, instead of interpreting the

Serial No.09/807,943

April 29, 2004

Page 4

claims in light of the specification, in the present case the Examiner has compared the claims with the specification, and seemingly would require that all the details of the specific exemplary algorithm disclosed in the specification be incorporated into the claims. The claims must only particularly point out and distinctly claim the subject matter which the applicant regards as his invention. It is not the function of the claims to recite "all of the details" set forth in the specification. SRI International v. Matsushita Elec. Corp., 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985) (in banc)(it is not necessary to embrace in the claims or describe in the specifications all possible forms in which the claimed principle may be reduced to practice).

Here, the Examiner does not allege that the specification fails to provide a disclosure that adequately enables one skilled in the art to carry out the claimed invention. Instead, the Examiner alleges that because the claims omit the details set forth in the specification, they are non-enabled. This reasoning runs contrary to the established law on this issue. Under the enablement determination of 35 U.S.C. § 112, the claims must be read in conjunction with the specification to determine if they meet those requirements. S3 Inc. v. nVIDIA, 259 F.3d 1364, 1367 (Fed. Cir. 2001) (if the claims when read in light of the specification reasonably disclose the scope of the invention, then the requirements of § 112 are met). If claims had to include all details of the specification, then there would be no need for claims at all. See SRI v. Matsushita, 775 F.2d 1107 at 1121.

The Examiner's allegation that no guidance, direction of examples are provided such that one of ordinary skill in the art would have known how to practice the claimed invention is wholly unsupported by any evidence of record – the Examiner has failed to

Serial No.09/807,943

April 29, 2004

Page 5

properly interpret the claims and also has failed to make any determination as to the level of ordinary skill in the art or what knowledge such a person would have.

Conclusion

In view of the foregoing, claims 1-17 are submitted to be in full compliance with the requirements of 35 U.S.C. §§ 112 and 101, and are patentable. Favorable reconsideration of this application and the issuance of a Notice of Allowance are earnestly solicited.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

RESPECTFULLY SUBMITTED,					
NAME AND REG. NUMBER	Vincent M. DeLuca Attorney for Applicants Registration No. 32,408				
SIGNATURE	Vincent M De Luca			DATE	29 APR 04
Address	Rothwell, Figg, Ernst & Manbeck 1425 K Street, N.W., Suite 800				
City	Washington	State	D.C.	Zip Code	20005
Country	U.S.A.	Telephone	202-783-6040	Fax	202-783-6031